



UNITED STATES DISTRICT COURT WESTERN DISTRICT OF TENNESSEE

LOCAL PATENT RULES

September 19 , 2011

I. SCOPE OF THE RULES

1.1 Title

These are the Local Patent Rules for the United States District Court for the Western District of Tennessee. They should be cited as “LPR ____.”

1.2 Scope and Construction

These rules apply to all civil actions filed in, removed, or transferred to this Court which allege infringement of a patent in a complaint, counterclaim, cross-claim, or third party claim, or which seek a declaratory judgment that a patent is not infringed, is invalid, or is unenforceable. The Local Rules of this Court shall also apply to such actions, except to the extent that they are inconsistent with these Local Patent Rules. If the filings or actions in a case do not trigger the application of these Local Patent Rules under the terms set forth herein, the parties shall, as soon as such circumstances become known, meet and confer for the purpose of agreeing on the application of these Local Patent Rules to the case and promptly report the results of the meeting to the Court.

1.3 Commencing Discovery

For all actions to the Local Patent Rules, discovery is permitted to begin upon the filing of the Answer or a motion under Rule 12 of the Federal Rules of Civil Procedure (each, a “Responsive Pleading”) absent an order from the Court stating otherwise.

1.4 Cases Received After the Responsive Pleading

If the Court obtains jurisdiction over an action subject to the Local Patent Rules after a Responsive Pleading has been filed, the time for serving disclosures set forth in LPR 1.4, 3.1, 3.5, 3.8, and 4.1 shall commence from the day the Court acquires jurisdiction, rather than the date the Responsive Pleading is filed.

1.5 Modification of Obligations

The Court may modify the obligations or deadlines set forth in these Local Patent Rules based on the circumstances of any particular case, including, without limitation, the simplicity or complexity of the case as shown by the patents, claims, products, or parties involved. Such modifications shall, in most cases, be made at the Patent (Scheduling Conference, but may be made at other times by the Court *sua sponte* or upon a showing of good cause.

1.6 Effective Date

These Local Patent Rules take effect on September 19, 2011. For actions pending before the effective date, the Court will confer with the parties and apply these rules as the Court deems practicable.

II. GENERAL PROVISIONS

2.1 Governing Procedure

(a) **Patent Scheduling Conference Notice.** Within seven (7) business days after the Responsive Pleading is filed, the parties shall jointly file a Notice (“Patent Scheduling Conference Notice”) via the Court’s Electronic Filing System informing the Court whether:

- (1) the action is ripe to be scheduled for a Patent Scheduling Conference at the Court’s earliest convenience,
- (2) the requirements under these Local Patent Rules should be modified in any way and the requested modifications, and
- (3) any other case management issues identified that would impact any party’s ability to conform to these Local Patent Rules.

Before submitting the Patent Conference Scheduling Notice, the parties shall meet and confer to try to reach an agreement upon any issues to be raised with the court.

(b) **Planning Meeting.** At least fourteen (14) days prior to the Patent Scheduling Conference, the parties shall confer to discuss and address in the Joint Planning Report and Proposed Scheduling Order the topics set forth in Federal Rule Civil Procedure 26(f) and Local Rule 16.1(e), as well as the following topics:

- (1) Any modification to the deadlines set by these Local Patent Rules;
- (2) Any anticipated motions that might affect the deadlines set by these Local Patent Rules, including motions for preliminary injunction and to add or substitute parties, and a proposed briefing schedule;
- (3) Any issues that might be the proper subject of an early motion for summary judgment or partial summary judgment;
- (4) The field of the claimed invention(s), claims asserted, number of claim terms to

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be construed, and the allegedly infringing activity or product;

- (5) Any modification to the limits on interrogatories and/or depositions set forth in the Federal Rules of Civil Procedure;
- (6) Any deviations from the form Patent Protective Order set forth in Appendix A to these Local Patent Rules;
- (7) The format of the Claim Construction Hearing, including whether the Court will hear live testimony, the order of presentation, and the estimated length of the hearing;
- (8) Whether the parties will agree to the electronic exchange of pleadings, notices, discovery, and other mandated disclosures not otherwise served electronically via the Court's electronic filing system; and
- (9) The susceptibility of this action to resolution by Alternative Dispute Resolution.

(c) **Joint Planning Report and Proposed Scheduling Order.** At least seven (7) days prior to the Patent Scheduling Conference, the plaintiff, on behalf of all parties, must file with the Court a Joint Planning Report and Proposed Scheduling Order in the form provided in Appendix B to these Local Patent Rules or in any other form ordered by the Court. Statements made by the parties in the Joint Planning Report and Proposed Scheduling Order will be used for case management purposes only and shall not be used to limit or otherwise restrict a party's ability to seek relief from the Court at a later date with respect to issues addressed or not addressed in the Joint Planning Report and Proposed Scheduling Order.

(d) **Patent Scheduling Conference.**

(1) Agenda. The general agenda for the Patent Scheduling Conference is set by Local Rule 16.1. The parties also should be prepared to discuss with the Court all of the matters addressed in the parties' Joint Planning Report and Proposed Scheduling Order, including the status of settlement discussions and the utilization of Alternative Dispute Resolution methods under Local Rule 16.2.

(2) Technology At Issue. Each party should be prepared to discuss the technology at issue during the Patent Scheduling Conference. This includes the general technology at issue, the patent(s) in suit, and each accused apparatus, product, device, process, method, act, or other instrumentality of each opposing party that is accused of infringing (each, an "Accused Instrumentality"). In addition to the foregoing, each party opposing a claim of infringement is expected to bring a sample or representation (e.g., photographs, video, specifications, etc.)

of each Accused Instrumentality.

(3) Attendance by Parties. All parties, lead counsel, and a representative with full authority for settlement purposes shall attend the Patent Scheduling Conference. “Parties” means either the named individuals or, in the case of a corporation or similar legal entity, a person familiar with the facts of the case, including the patented technology or allegedly infringing technology.

2.2 Confidentiality

Discovery cannot be withheld on the basis of confidentiality absent Court order. Pending entry of a protective order, discovery and disclosures deemed confidential by a party shall be produced to the adverse party for the eyes of outside counsel of record only, marked “Attorney's Eyes Only – Subject to Protective Order.” The discovery and disclosures so marked shall be used solely for purposes of the pending case and shall not be disclosed to the client or any other person.

Should the parties desire to have a protective order entered in a patent case, they shall present a stipulated protective order for the Court's consideration and entry at the Patent Scheduling Conference. In the absence of a stipulated protective order, a party that has designated discovery or disclosures for protection under this Rule or that desires to have a protective order entered in the case shall move the Court for the entry of the Patent Case Protective Order attached as Appendix A to these Rules. Upon entry of a protective order, discovery and disclosures previously designated for protection under this Rule may be re-designated, disclosed, and used in accordance with the provisions of the protective order entered by the Court.

Should a party desire to file materials designated for protection under this Rule with the Court before the entry of a protective order, the materials shall be filed under seal and this Rule shall authorize the Clerk of Court to accept the sealed filing.

2.3 Relationship to Federal Rules of Civil Procedure and Local Civil Rules for the United States District Court, Western District of Tennessee

A party may not object to discovery on the ground that it conflicts with or is premature under the Local Patent Rules, except to the following categories of requests and disclosures:

- (a) Requests for a party's claim construction position;
- (b) Requests for the same information required to be disclosed under Local Patent Rules 3.1-3.7; and
- (c) Requesting that an accused infringer identify whether it intends to rely upon the opinion(s) of counsel as a defense against an allegation of willful infringement.

Federal Rule of Civil Procedure 26(e)'s requirements concerning the supplementation of disclosure and discovery responses apply to all disclosures required under the Local Patent Rules.

III. PATENT DISCLOSURES

3.1. Initial Infringement Contentions.

Within seven (7) days after the Responsive Pleading is filed, a party claiming patent infringement shall serve on all parties Initial Infringement Contentions containing at least the following information:

- (a) Each claim of each patent in suit that is allegedly infringed by each opposing party, including for each claim the applicable statutory subsections of 35 U.S.C. § 271 ("Infringement of Patent") asserted;
- (b) Separately for each asserted claim, each Accused Instrumentality that each party claiming infringement contends infringes, including the name or model number if known;
- (c) A chart identifying specifically where each limitation of each asserted claim is found within each Accused Instrumentality, including for each limitation that such party contends is governed by 35 U.S.C. § 112(6), the identity of the corresponding structure and function and where such structure and function is found in the Accused Instrumentality;
- (d) For each claim which is alleged to have been indirectly infringed, an identification of any direct infringement and a description of the acts of the alleged indirect infringer(s) that contribute to or that are inducing direct infringement, including a description of the role of each relevant party if direct infringement is based on the joint acts of multiple parties;
- (e) Whether each limitation of each asserted claim is alleged to be literally present or present under the doctrine of equivalents in the Accused Instrumentality;
- (f) For any patent that claims priority to an earlier application, the priority date to which each asserted claim allegedly is entitled; and
- (g) If a party claiming patent infringement alleges willful infringement, the basis for such allegation.

3.2. Document Production Accompanying Initial Infringement Contentions.

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With the Infringement Contentions, the party claiming patent infringement shall produce to each opposing party or make available for inspection and copying:

- (a) All documents concerning any disclosure, sale or transfer, or offer to sell or transfer of the claimed invention prior to the bar date under 35 U.S.C. § 102(b) and/or the date of invention for the patent in suit;
- (b) All documents evidencing the conception and first reduction to practice of each claimed invention, which were created on or before the date of application for the patent in suit or the priority date identified pursuant to LPR 3.1(f), whichever is earlier;
- (c) A copy of the file history for each patent in suit (or so much thereof as is in the possession of the patentee) and any patent(s) or application(s) to which each patent in suit claims priority; and
- (d) All documents evidencing ownership of the patent rights by the party asserting patent infringement.

Nothing in these required disclosures shall be considered an admission that such disclosures are prior art or evidence of prior art under 35 U.S.C. § 102 or § 103.

3.3. Initial Non-infringement Contentions.

Within (28) days after service of the Initial Infringement Contentions, each party opposing a claim of patent infringement, shall serve on all parties Non-infringement Contentions which shall contain the following information:

- (a) A chart, responsive to the chart required by LPR 3.1(c), that identifies as to each identified element in each asserted claim (1) whether such element is present literally or under the doctrine of equivalents in each Accused Instrumentality and, if not, the reason for such denial and the relevant distinctions, and (2) for each limitation that such party contends is governed by 35 U.S.C. § 112(6), the corresponding structure and function, (if different from that identified in LPR 3.1(c)), whether or not such structure and function are found in the Accused Instrumentality, and/or any basis for claiming that such limitation is invalid for indefiniteness; and
- (b) A statement that the proper parties have been served or, if the proper parties have not been served, a statement identifying the proper parties to the extent they are known.

3.4. Document Production Accompanying Initial Non-infringement Contentions.

With its Non-infringement Contentions, the party opposing a claim of patent infringement shall produce or make available for inspection and copying:

- (a) Documents sufficient to support the statement(s) made in the chart required by LPR 3.3(a);
- (b) Documents sufficient to evidence the actual parties that make and sell the Accused Instrumentality or any other documents sufficient to support the statement(s) made in response to LPR 3.3(b); and
- (c) Documents sufficient to describe the structure, composition, and/or operation of the Accused Instrumentality.

3.5. Invalidity and Unenforceability Contentions

Within ninety (90) days after the Responsive Pleading is filed, each party asserting that a claim of a patent is invalid or unenforceable, shall serve on all parties its Invalidity and Unenforceability Contentions which shall contain at least the following information:

- (a) The identity of each item of prior art that allegedly anticipates each asserted claim or renders it obvious. Each prior art patent shall be identified by its number, country of origin, and date of issue. Each prior art publication shall be identified by its title, date of publication, and where feasible, author and publisher. Prior art under 35 U.S.C. § 102(b) shall be identified by specifying the item offered for sale or publicly used or known, the date the offer or use took place or the information became known, and the identity of the person or entity which made the use or which made and received the offer, or the person or entity which made the information known or to whom it was made known. Prior art under 35 U.S.C. § 102(f) shall be identified by providing the name of the person(s) from whom and the circumstances under which the invention or any part of it was derived. Prior art under 35 U.S.C. § 102(g) shall be identified by providing the identities of the person(s) or entities involved in and the circumstances surrounding the making of the invention before the patent applicant(s);
- (b) Whether each item of prior art anticipates each asserted claim or renders it obvious under 35 U.S.C. §102 or §103. If obviousness is alleged, an explanation of why the prior art renders the asserted claim obvious, including an identification of any combinations of prior art showing obviousness;
- (c) For each alleged item of prior art, a chart identifying specifically where each limitation of each asserted claims are found, including for each limitation that such party contends is governed by 35 U.S.C. § 112(6), the identity of the structure(s), act(s), or material(s) in each item of prior art that performs the

claimed function;

- (d) Any grounds of invalidity based on 35 U.S.C. § 101, or 35 U.S.C. § 112, including invalidity contentions based on written description, enablement, indefiniteness, and/or best mode.
- (e) The grounds for any charge that any of the asserted claims are unenforceable for inequitable conduct, including the identification of any information alleged to have been withheld, misstated, or otherwise misrepresented to the United States Patent Office, the basis for claiming such information was material to patentability, and the basis for claiming that the patentee withheld, misstated, or misrepresented such information with the requisite intent.

3.6. Document Production Accompanying Invalidity and Unenforceability Contentions.

With its Invalidity and Unenforceability Contentions, any party opposing a claim of patent infringement shall produce or make available for inspection and copying:

- (a) A copy or sample of the prior art identified pursuant to LPR 3.5(a). To the extent any such item is not in English, an English translation of the portion(s) relied upon shall be produced. The producing party shall separately identify by production number which documents correspond to each invalidity category; and
- (b) All documents supporting any statement(s) made in response to LPR 3.5(e).

3.7 Validity and Enforceability Contentions.

Within twenty-one (21) days after service of the Invalidity and Unenforceability Contentions, each party opposing a claim of inequitable conduct and/or invalidity shall serve on all parties Validity and Enforceability Contentions which shall contain the following information:

- (a) A chart, responsive to the chart required by LPR 3.5(c) that identifies each limitation of each asserted claim that is missing from the asserted prior art;
- (b) A responsive statement explaining why the disclosures and statement required by LPR 3.5 (e) do not render the asserted patents unenforceable;
- (c) All documents supporting the disclosures made in LPR 3.7 (a)-(b) to the extent that they have not already been produced.

3.8 Final Contentions

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- (a) Final Infringement Contentions. Within fourteen (14) days after the Court's Claim Construction Ruling is issued, each party claiming patent infringement shall serve on all parties "Final Infringement Contentions" containing the information required by LPR 3.1.
- (b) Final Non-infringement Contentions, Final Invalidity and Unenforceability Contentions. Within fourteen (14) days after the Court's Claim Construction Ruling is issued, each party asserting non-infringement, invalidity or unenforceability of a patent claim shall serve on all other parties "Final Non-infringement Contentions" and "Final Invalidity and Unenforceability Contentions" containing the information required by LPR 3.3 and 3.5. With the Final Invalidity Contentions, the party asserting invalidity of any patent claim shall produce or make available for inspection and copying a copy or sample of all prior art identified pursuant to LPR 3.6, to the extent not previously produced. If any such item is not in English, an English translation of the portion(s) relied upon shall be produced. The producing party shall separately identify by production number which documents correspond to each category.
- (c) Final Validity and Enforceability Contentions. Within forty-five (45) days after the Court's Claim Construction Ruling is issued, each party claiming patent infringement must serve on all parties "Final Validity and Enforceability Contentions" containing the information required by LPR 3.7.
- (d) Amendments to Final Contentions. A party may amend the final contentions required under LPR 3.8(a)-(c) only by order of the Court upon a showing of good cause and absence of unfair prejudice, made in timely fashion following discovery of the basis for such amendment. The duty to supplement discovery responses does not excuse the need to obtain leave of court to amend contentions.

3.9 Disclosure Requirements for Patent Cases for Declaratory Judgment of Invalidity

In all cases in which a party files a complaint or other pleading seeking declaratory judgment that a patent is invalid, LPR 3.1-3.4 shall not apply unless and until a claim for patent infringement is made by a party in the Responsive Pleading. If the defendant does not assert a claim for patent infringement in its Responsive Pleading, the party seeking declaratory judgment of invalidity shall make its required disclosures under LPR 3.5 and 3.6 within thirty (30) days after the Responsive Pleading is filed. All other deadlines and requirements under the Local Patent Rules shall remain the same. This LPR 3.9 shall not apply to cases in which a request for a declaratory judgment that a patent is invalid is filed in response to a complaint for infringement of the same patent.

3.10 Disclosure Requirements for Patent Cases Arising Under 21 U.S.C. § 355 (commonly referred to as “the Hatch-Waxman Act”).

The following provision applies to all patents subject to a Paragraph IV certification in cases arising under 21 U.S.C. § 355 (commonly referred to as “the Hatch-Waxman Act”). This provision takes precedence over any conflicting provisions in LPR 3.1 to 3.8 for all cases arising under 21 U.S.C. § 355.

- (a) Production of New Drug Application. At or before the Patent Scheduling Conference, the Defendant(s) shall produce to Plaintiff(s) the entire Abbreviated New Drug Application or New Drug Application that is the basis of the case in question.
- (b) Invalidity Contentions. Within fourteen (14) days after the Patent Scheduling Conference, the Defendant(s) shall provide to Plaintiff(s) written Invalidity Contentions, for any patents referred to in Defendant(s) Paragraph IV Certification. At a minimum, these Invalidity Contentions should include those items required by LPR 3.5(a-d);
- (c) Production of Materials Supporting Invalidity Contentions. Any Invalidity Contentions disclosed under LPR 3.10(b) shall be accompanied by the production of any document or thing that each Defendant intends to rely on to show invalidity. At a minimum, this disclosure should comply with LPR 3.6(a).
- (d) Non-infringement Contentions. Within thirty (30) days after the Patent Scheduling Conference, the Defendant(s) shall provide to Plaintiff(s) the written basis for their Non-infringement Contentions for any patents referred to in Defendant(s) Paragraph IV Certification which shall include a claim chart as required by LPR 3.3(a) identifying each claim at issue in the case and each limitation of each claim at issue. The claim chart shall specifically identify for each claim which claim limitation(s) are literally absent from the Defendant(s) allegedly infringing Abbreviated New Drug Application or New Drug Application
- (e) Production of Materials Supporting Non-infringement Contentions. Any Non-infringement Contentions disclosed under LPR 3.10(d) shall be accompanied by the production of any document or thing that the Defendant(s) intend to rely on in defense against any infringement contentions by Plaintiff(s), including those items required by LPR 3.4(a).
- (f) Infringement Contentions. Within forty-five (45) days after the disclosure of

the Noninfringement Contentions as required by LPR 3.10(d), Plaintiff(s) shall provide Defendant(s) with Infringement Contentions for all patents referred to in Defendant(s) Paragraph IV Certification, including, at a minimum, those items required by LPR 3.1.

- (g) Production of Materials Supporting Infringement Contentions. Any Infringement Contentions disclosed under LPR 3.10(f) shall be accompanied by the production of documents required under LPR 3.2.

3.11. Amending and Supplementing Contentions.

- (a) Unless otherwise ordered by the Court, the parties' contentions and responses shall have the same binding effect on a party as a response to an interrogatory made under Rule 33 of the Federal Rules of Civil Procedure. The parties' disclosures and responses may be amended or supplemented without leave of court until the Final Contentions are due under LPR 3.8(a)-(c); provided, however, that after submission of the exchange of claim terms under LPR 4.1(c), additional claims in the patent(s) in suit may not be asserted without obtaining leave from the Court for good cause shown.

3.12. Final Date to Seek Stay Pending Reexamination

Absent exceptional circumstances, no party may file a motion to stay the lawsuit pending reexamination in the U.S. Patent Office after the due date for service of that party's Final Contentions.

IV. CLAIM CONSTRUCTION PROCEEDINGS

4.1 Exchange of Proposed Terms for Construction

- (a) Preliminary Identification of Claim Terms to be Construed. Within ninety-five (95) days after the Responsive Pleading is filed, each party shall serve on each other party a list of claim terms which that party contends should be construed by the Court, and identify any claim terms which that party contends should be governed by 35 U.S.C. §112(6).
- (b) Meet and Confer. The parties shall thereafter meet and confer for the purposes of limiting the terms in dispute by narrowing or resolving differences and facilitating the ultimate preparation of a Joint Claim Construction and Pre-hearing Statement.
- (c) Final Identification of Claim Terms to be Constued, Within one hundred and fifteen (115) days after the Responsive Pleading is filed, each party shall

serve on each other party a final list of claim terms which that party contends should be construed by the Court, including any claim terms which that party contends should be governed by 35 U.S.C. §112(6).

4.2 Exchange of Preliminary and Final Claim Constructions and Evidence

- (a) Preliminary Claim Construction. Within fourteen (14) days after the exchange of the lists pursuant to LPR 4.1(c), the parties shall simultaneously exchange preliminary proposed constructions of each term identified by any party for claim construction. Each such “Preliminary Claim Construction” shall also, for each term which any party contends is governed by 35 U.S.C. § 112(6), identify the structure(s), act(s), or material(s) corresponding to that term’s function.
- (b) Supporting Materials. At the same time the parties exchange their respective “Preliminary Claim Constructions,” each party shall also identify all references from the specification or prosecution history that support its preliminary proposed construction and designate any supporting extrinsic evidence including, without limitation, dictionary definitions, citations to learned treatises and prior art and testimony of all witnesses including expert witnesses. Extrinsic evidence shall be identified by production number or by producing a copy if not previously produced. The parties shall further identify any fact witness including a brief description of the subject matter of each witness’ anticipated testimony.
- (c) Final Claim Construction. Within seven (7) days after the completion of expert claim construction discovery pursuant to LPR 4.3(c) or fifty (50) days after the exchange of Preliminary Claim Constructions pursuant to LPR 4.2(b) in the event that no expert is identified, the parties shall simultaneously exchange final proposed constructions of each term identified by any party for claim construction. Each such “Final Claim Construction” shall also, for each term which any party contends is governed by 35 U.S.C. § 112(6), identify the structure(s), act(s), or material(s) corresponding to that term’s function. The parties shall also identify the information set forth in LPR 4.2(b), as well as any expert testimony the party intends to rely upon in support of its proposed claim construction.

4.3 Expert Claim Construction Discovery

- (a) Initial Expert Claim Construction Reports. Within fourteen (14) days after the exchange of Preliminary Claim Constructions pursuant to LPR 4.2(a),

any party planning to use an expert witness at the claim construction hearing shall identify that witness and produce a copy of the expert's curriculum vitae and any expert report or declaration the party intends to rely upon.

- (b) Rebuttal Expert Claim Construction Report. Within fourteen (14) days after the disclosure of initial expert claim construction reports pursuant to LPR 4.3(a), any party planning to use a rebuttal expert witness at the claim construction hearing shall identify that witness and produce a copy of the expert's curriculum vitae and any expert report or declaration the party intends to rely upon.
- (c) Completion of Expert Discovery. Within fourteen (14) days after the disclosure of rebuttal expert claim construction reports pursuant to LPR 4.3(b), the parties shall complete any depositions of any experts identified under LPR 4.3.

4.4 Claim Construction Briefs

- (a) Opening Claim Construction Briefs. Within fourteen (14) days after exchanging Final Claim Constructions pursuant to LPR 4.2(c), the parties shall contemporaneously file and serve their opening claim construction briefs and any evidence supporting claim construction, including witness testimony or declarations.
- (b) Responsive Claim Construction Briefs. Within thirty (30) days after the filing of the Opening Claim Construction Briefs are filed, the parties shall contemporaneously file and serve Responsive Claim Construction Briefs and any evidence supporting claim construction, including any responding experts' certifications or declarations.
- (c) Length. Without prior approval of the Court, all memoranda related to Claim Construction Briefs shall be limited to twenty-five (25) pages. Appendices of evidentiary, statutory or other materials are excluded from these page limitations and may be bound separately from the memorandum.

4.5 Joint Claim Construction and Prehearing Statement

Within seven (7) days after the Responsive Claim Construction Briefs under LPR 4.4(b) are filed, the parties shall complete and file a Joint Claim Construction and Pre-

hearing Statement, which shall contain the following information:

- (a) The construction of those terms on which the parties agree;
- (b) Each party's proposed construction of each disputed term, together with an identification of all references from the intrinsic evidence that supports that construction, and an identification of any extrinsic evidence known to the party on which it intends to rely either to support its proposed construction or to oppose any other party's proposed construction, including, but not limited to, as permitted by law, dictionary definitions, citations to learned treatises and prior art, and testimony of all witnesses including experts;
- (c) An identification of the terms that each of the parties contend (i) would require a disposition of the case in its favor and/or (ii) will be substantially conducive to promoting settlement. For any such terms, each of the parties shall also include a brief statement, not to exceed one page, supporting or refuting the contention that the construction of those terms will be dispositive or promote settlement. The Court may, at its option, solicit additional briefing regarding the dispositive nature of any terms prior to the claim construction hearing or upon issuing its claim constructions.
- (d) The anticipated length of time necessary for the Claim Construction Hearing;
- (e) Whether any party proposes to call one or more witnesses at the Claim Construction Hearing, the identity of each such witness, and for each witness a brief description of the subject matter of each witness' anticipated testimony; and
- (f) A list of other issues that might appropriately be taken up at a prehearing conference prior to the claim construction hearing and, if not previously set, proposed dates for any such prehearing conference.

4.6 Claim Construction Hearing

Subject to the convenience of the Court's calendar, the Court shall conduct a Claim Construction Hearing within thirty (30) days after the Responsive Claim Construction Brief are filed to the extent the parties or the Court believe a hearing is necessary for construction of the claims at issue. Prior to the hearing, the parties shall contact the Court to make arrangements for any uses of courtroom technology, such as demonstrations, Powerpoint® presentations or evidence presentation

programs. At the hearing, the parties shall submit the best available specimens of patented technology and allegedly infringing activity (e.g. products, schematics, photos, product information sheets).

4.7 Close of Fact Discovery; Status Conference

Unless otherwise ordered by the Court, fact discovery for all actions subject to these Local Patent Rules shall end no later than thirty (30) days after the Court's Claim Construction Ruling is issued. The parties shall also appear for a status conference (in person or telephonically, at the option of the Court) within thirty (30) days of that ruling.

In addition to updating the Court regarding the status of the pending litigation, each party shall inform the Court whether mediation of the dispute is appropriate during the status hearing. The Court, at its option, may refer any case subject to these rules to mediation as under Local Rule 16.2 upon request of one or both the parties or *sua sponte*. Any party objecting to its case being selected for mediation may file a motion to be relieved of the obligation as required by Local Rule 16.2(e). A failure to participate in good faith in the mediation may expose a party and/or its counsel to sanctions.

4.8 Advice of Counsel

Unless otherwise ordered by the Court, ninety (90) days before the close of fact discovery, each party relying upon advice of counsel as part of a patent-related claim or defense for any reason shall produce or make available for inspection and copying any written advice and documents related thereto. Regardless of the deadline for the completion of fact discovery, if a party relies on advice of counsel, the opposing party shall be afforded an adequate opportunity to obtain discovery pertaining to such advice.

A party who does not comply with the requirements of this LPR 4.8 shall not be permitted to rely on advice of counsel for any purpose absent a stipulation of all parties or by order of the Court.

V. EXPERT DISCOVERY

5.1 Disclosure of Experts and Expert Reports

Unless the Court orders otherwise:

(a) Scope. For issues other than claim construction to which expert testimony shall be directed, expert witness disclosures and depositions shall be governed by this Rule;

(b) Initial Expert Witness Disclosures. Within sixty (60) days after the Court's Claim Construction Ruling is issued, each party shall make its initial expert witness disclosures required by Rule 26 of the Federal Rules of Civil Procedure on issues for which it bears the burden of proof; and

(c) Rebuttal Expert Witness Disclosures. Within thirty (30) days after service of the Initial Expert Witness Disclosures required by LPR 5.1(b) each party shall make its rebuttal expert witness disclosures required by Rule 26 of the Federal Rules of Civil Procedure on the issues for which the opposing party bears the burden of proof.

5.2. Depositions of Experts

Within forty (40) days after service of Rebuttal Expert Witness Disclosure, depositions of expert witnesses shall be completed.

5.3. Presumption Against Supplementation of Reports

Amendments to, or supplementation of expert reports after the deadlines provided herein are presumptively prejudicial and shall not be allowed absent prior leave of court upon a showing of good cause that the amendment or supplementation could not reasonably have been made earlier and that the opposing party is not unfairly prejudiced.

VI. DISPOSITIVE MOTIONS AND TRIAL

6.1. Filing Dispositive Motions

All dispositive motions shall be filed within fourteen (14) days after the scheduled date for the end of expert discovery.

6.2. Trial

Unless otherwise ordered by the Court, and subject to the convenience of the Court's calendar, a Trial on all cases subject to these rules shall be conducted within one hundred twenty (120) days after the deadline for filing dispositive motions.

